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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,253	09/26/2003	Jeyhan Karaoguz	15025US02	8824
23446 7590 04/09/2007 MCANDREWS HELD & MALLOY, LTD 500 WEST MADISON STREET SUITE 3400 CHICAGO, IL 60661			EXAMINER JEAN, FRANTZ B	
			ART UNIT 2151	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	
3 MONTHS			04/09/2007	
			DELIVERY MODE PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/672,253

Applicant(s)

KARAOGUZ ET AL.

Examiner

Frantz B. Jean

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This is a first office action in response to application for patent filed on 09/26/03. Claims 1-23 are presented for examination.

#### ***Specification***

The cross-reference to related applications cited on page 2 of the specification is incomplete. Applicant is requested to provide or update the serial number of the application.

#### ***Priority***

This application claims benefit of application number 60/467,867 filed on 05/05/03, application number 60/60/432,472 filed on 12/11/02 and application number 60/443,894 filed 01//30/03. The claim for benefit of relying on the filing date of the prior application under 35 U.S.C. 119 (e), 120, 121, or 365 (e) is acknowledged.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-23 of the instant application are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of copending Application No. 10/657,390, claims 1-24 of copending Application No. 10/672,864, and claims 1-24 of copending Application No. 10/672,654. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application recites a television display, a storage, and a user interface, but lacks the specific language of a first and a second television display, a first and second user interface and storage. However, the claims encompass the same metes, bounds, and limitations. Therefore, it would be obvious to eliminate the limitations of the narrower claims, since it has been held that omission of an element and its function and a combination where the remaining elements perform the same functions as before involves only routine skill in the art. See *in re Karlson*, 136 USPQ 184.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." >The Federal Circuit's en banc decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Oz et al. ("Oz") US Patent Number 7,181,159.

As per claim 1, Oz teaches a system supporting user defined filtering of media consumption in a media exchange network, the system comprising: a television display (fig 1, television set) supporting consumption of media via a communication network; a storage for storing media (col. 12 line 11), the storage communicatively coupled to the television display, and having an associated first network address; a user interface (162, fig 1) for display on the television display, the user interface having at least one view comprising a collection of media channels, each media channel in the collection of media channels comprising a sequence of media available to a first user, the display and consumption of each media channel subject to at least one media filter, the at least one media filter comprising characteristics of media defined by a second user (col 6 lines 37-46; col. 7 lines 44-57; col. 8 lines 7-30); at least one server (fig 7, 252) supporting the consumption of media, and having an associated second network address; and server software (col. 14 lines 18-47) that receives via the communication network a request identifying one of the associated first and second network addresses,

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and that responds by identifying the other of the associated first and second network addresses to coordinate the consumption of media.

As per claim 2, Oz teaches a system of claim 1 wherein the media comprises at least one of audio, a still image, video, real time video, and data (col. 12 lines 24-34).

As per claim 3, Oz teaches a system of claim 1 wherein the first and second network addresses are one of an Internet protocol (IP) address, a media access control (MAC) address, and an electronic serial number (ESN) (see fig 7 and 9).

As per claim 4, Oz teaches a system of claim 1 wherein the communication network comprises at least one of a cable infrastructure, a satellite network infrastructure, a digital subscriber line (DSL) infrastructure, an Internet infrastructure, an intranet infrastructure, a wired infrastructure, and a wireless infrastructure (see fig 2A and 2B).

As per claim 5, Oz teaches a system of claim 4 wherein the communication network is the Internet (element 126, fig 2A).

As per claim 6, Oz teaches a system of claim 1 wherein consumption comprises at least one of playing digitized audio, displaying a still image, displaying video, and displaying data (col. 12 lines 24-41).

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As per claim 7, Oz teaches a system of claim 1 wherein the characteristics of media comprise at least one of a type of media channel, a language of dialogue, an industry rating, a overall viewer rating, a mode, a video quality, a format, a bandwidth, a year of release, an artist, and one or more words of a title (col. 12 lines 6-51).

As per claim 8, Oz teaches a system of claim 1 wherein the at least one media filter supports combinations of the characteristics of media using Boolean relations (col. 6 lines 37-46, col. 7 lines 44-57; col. 8 lines 7-30; col. 12 lines 6-51).

As per claim 9, Oz teaches a system of claim 1 wherein at least one period of time for which the at least one media filter is effective is defined by at least one of the first user and the second user (col. 6 lines 37-46, col. 7 lines 44-57; col. 8 lines 7-30).

As per claim 10, Oz teaches a system of claim 1 wherein the at least one media filter may be at least one of enabled, disabled, created, deleted, and modified via the communication network (col. 6 lines 37-46; col. 29 lines 32-43).

As per claim 11, Oz inherently teaches a system of claim 1 further comprising: a remote control supporting the selection of media for consumption; and the media available for selection using the remote control being determined according to the at least one media filter (col. 12 lines 17-34).



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As per claim 12, Oz teaches a system of claim 1 wherein the first user and the second user are the same user (fig 1).

Claims 13-23 contain the same limitations as discussed in claims 1-12 above. Therefore, they are rejected under the same rationale.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz B. Jean whose telephone number is 571-272-3937. The examiner can normally be reached on 8:30-6:00 M-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on 571 272 3939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Frantz Jean

  
**FRANTZ B. JEAN**  
**PRIMARY EXAMINER**